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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,074	02/05/2001	Hironori Kobayashi	P/3760-2	2704

2352 7590 02/12/2004

OSTROLENK FABER GERB & SOFFEN
1180 AVENUE OF THE AMERICAS
NEW YORK, NY 100368403

EXAMINER

HAQ, NAEEM U

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 02/12/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/777,074

Applicant(s)

KOBAYASHI, HIRONORI

Examiner

Naeem Haq

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 February 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Drawings

New corrected drawings are required because this application has been filed with informal drawings which are acceptable for examination purposes only. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance. See PTO-948 for additional information.

Specification

The disclosure is objected to because of the following informalities: The reference character "24" refers to both "products" and "indicia" on page 13, lines 7 and 8 respectively. Appropriate correction is required.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 24, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "in proximity" in claims 1, 24, and 29 is a relative phrase which renders the claim indefinite. This phrase is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprised of the scope of the invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-16, 18-20, and 22-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US Patent 5,979,757) in view of Perkowski (US 2004/0019535 A1).

Referring to claims 1, 7, 8, 18-20, 23, 24, 25, and 29, Tracy teaches a system for effecting procurement of desired items which include products or services or information content, the system comprising: a portable, hand-held user tool, comprising a facility for reading, storing and forwarding identification indicia appearing on the desired items (Figures 2 and 5; column 4, line 1 – column 5, line 46); a central agent facility configured to communicate with a plurality of the user tools and constructed to receive from the hand-held user tools the identification indicia (column 5, line 47 – column 6, line 25); a database associated with the central agent facility that receives the desired item identification information received from the hand-held user tools (column 5, line 66

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– column 6, line 7); a data gathering facility associated with the central agent facility which communicates to the suppliers users requests for the desired items and receives information from the suppliers relevant thereto; and wherein the central agent facility communicates to the user tools selective information pertaining to the desired items (column 5, line 66 – column 6, line 25). Tracy does not teach that the database correlates the desired item identification information received from the hand-held user tools with corresponding supply source information for the desired items available at or from a plurality of suppliers. However, Perkowski teaches a system for retrieving information about a product using a hand-held bar code scanner wherein the item identification information (bar code) received from the hand-held is correlated with corresponding supply source information (page 4, paragraphs [0044] and [0045]; page 13, paragraphs [0130] – page 16, paragraph [0156]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Perkowski into the system of Tracy. One of ordinary skill in the art would have been motivated to do so in order to allow the consumer to communicate directly with the supplier.

Referring to claim 2, Tracy and Perkowski do not explicitly disclose that the mode of operation for the sensor is selected from the group including: optical, magnetic, infrared, sound and bio-sensor. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate any of the modes of operation listed above into the system and method of the cited prior. The Applicant has not disclosed that the listed modes provide an advantage, are used for a particular

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purpose or solve a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with any mode of operation because the scanners described in the prior art must use some sort of image processing to capture the information contained on the bar code label. Therefore, it would have been obvious to one of ordinary skill in this art to modify the cited prior art to obtain the invention as specified in the claims.

Referring to claim 3, Tracy teaches that the sensor is incorporated in a mobile terminal (Figures 4 and 5).

Referring to claim 4, Tracy teaches that the tool has reduced memory requirements (column 3, lines 49-54).

Referring to claims 5, 6, and 26, Tracy teaches that the tool is operable in both an on-line and off-line mode (column 3, lines 30-60).

Referring to claims 9-15, Tracy does not a plurality of auxiliary facilities. However, Perkowski teaches these features (page 1, paragraph [0007]; Figure 1; page 5, paragraph [0063]; page 8, paragraph [0098]; page 9, paragraph [0107] – page 10, paragraph [0109]). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Perkowski into the system and method of Tracy. One of ordinary skill in the art would have been motivated to do so in order to facilitate a transaction between a consumer, retailer, and supplier.

Referring to claims 16 and 27, Tracy teaches that the customer tool comprises an e-navigator software facility which effects communication with the agent facility (column 3, line 30 – column 5, line 46).

Referring to claims 22 and 28, Tracy and Perkowski do not explicitly disclose providing responses to requests from the user tools by communicating to users by means of a communication mode selected from a group including: e-mail, facsimile, letter and automatically triggered voice telephone messages. However, at the time the invention was made, it would have been obvious to one of ordinary skill in the art to incorporate these features into the system and method of the cited prior art. The Applicant has not disclosed that these communication modes provide an advantage, are used for a particular purpose or solve a stated problem. Furthermore, one of ordinary skill in the art would have expected Applicant's invention to perform equally well with the communication mode of the cited prior art because all these communication modes are capable of convey the same message. Therefore, it would have been obvious to one of ordinary skill in this art to modify the prior art to obtain the invention as specified in the claims.

Claims 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tracy et al. (US Patent 5,979,757) in view of Perkowski (US 2004/0019535 A1) and further in view of Jelen et al (US Patent 6,129,276).

Referring to claims 17 and 21, the cited prior does not teach a automatic triggers, or a navigational facility which monitors the location of the user and provides navigational assistance to the user via the agent facility and the suppliers. However,

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Jelen teaches these features (column 9, line 56 – column 10, line 17). Therefore it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the teachings of Jelen into the system and method of the cited prior art. One of ordinary skill in the art would have been motivated to do so in order to provide targeted advertisement to a consumer based on the consumer's location, as taught by Jelen.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Naeem Haq whose telephone number is (703)-305-3930. The examiner can normally be reached on M-F 8:00am-5:00pm.

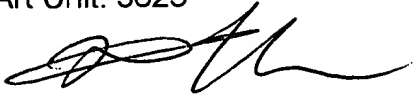
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff A. Smith can be reached on (703)-308-3588. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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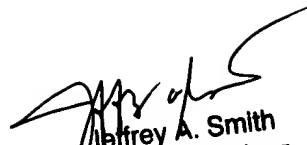
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Naeem Haq, Patent Examiner
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February 3, 2004



Jeffrey A. Smith
Primary Examiner